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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,034	12/14/2000	Werner Obrecht	MO5842/LEA 34092	4130
34947 7590 09/15/2011 LANXESS CORPORATION 111 RIDC PARK WEST DRIVE PITTSBURGH, PA 15275-1112				
EXAMINER				
SERGENT, RABON A				
ART UNIT		PAPER NUMBER		
1765				
NOTIFICATION DATE		DELIVERY MODE		
09/15/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipmail@lanxess.com

Office Action Summary**Application No.**

09/739,034

Applicant(s)

OBRECHT ET AL.

Examiner

Rabon Sergeant

Art Unit

1765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 8.9 and 23-32 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 8.9 and 23-32 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 5, 2011 has been entered.
2. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have claimed a rubber vulcanate and have further claimed that the vulcanate is utilized in specified molded rubber bodies. It is unclear how or to what extent the term, "rubber vulcanate" is modified by the language, "utilized in molded rubber bodies selected from ...". It cannot be determined if the rubber vulcanate is required to be in the form of a molded rubber body selected from those set forth within claim 8. Despite applicants' response, it remains unclear if the language denoted by "utilized" constitutes a statement of intended use or if the rubber vulcanate must be in the form of one of the specified bodies; if the latter is the case, then it is unclear why the claimed bodies have not been definitively claimed as comprising the rubber vulcanate. The position is taken that applicants' claim language sets forth a needless degree of ambiguity.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 8, 9, and 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Obrecht et al. ('488) or DE 19701487, each in view of JP 57-212239 or JP 5-17630.

The primary references disclose rubber mixtures comprising double bond containing rubber and crosslinked rubber particles having applicants' claimed properties, wherein the mixtures are useful for producing vulcanisates and molded articles, such as those claimed. See abstract; column 1, lines 31+; columns 2 and 3; and column 4, lines 49-59 within Obrecht et al. See abstract and page 4, line 3 within DE 19701487. Though the primary references are silent regarding the addition of a polyisocyanate component to the composition, the use of polyisocyanates within rubber mixtures to improve physical properties was known at the time of invention. This position is supported by the teachings of the secondary references. The secondary references disclose that polyisocyanate containing rubber formulations display excellent moldability and promote bonding of the rubber particles. See abstracts of secondary references. Furthermore, it is noted that paragraphs [0010] and [0011] of the translation of JP 57-212239 clearly teach that the composition therein may be used in the production of rubber

block molded bodies. Therefore, both of the relied upon secondary references clearly allow for the use of the disclosed compositions in the production of moldings.

5. Therefore, it would have been obvious to incorporate polyisocyanates within the rubber mixtures of the primary references, so as to produce rubber compositions having the improved moldability and bonding characteristics taught by the secondary references. This position is bolstered by the fact that it has been held that it is *prima facie* obvious to utilize a known component for its art recognized purpose. *In re Linder*, 173 USPQ 356. *In re Dial et al.*, 140 USPQ 244.

6. Applicants' response has been considered; however, it is insufficient to overcome the prior art rejection. Firstly, applicants' arguments with respect to Dammann et al. ('531) are moot in view of the removal of this reference from the rejection. Secondly, applicants' argument with respect to the combination of the primary references with JP 5-17630 is not well taken in view of the fact that it is specifically disclosed within paragraphs [0010] and [0011] of JP 5-17630 that the compositions therein may be used to produce rubber block molded bodies. Therefore, there is no justification for applicants' argument that the combination with the primary references would be expected render the production of molded rubber bodies unsuitable. Lastly, applicants' argument with respect to the combination of the primary references with JP 57-212239 is not well taken, because the argued phenolic resins of the secondary reference are not excluded from the instant claims. Accordingly, applicants' arguments concerning such non-excluded components are neither relevant to the issues at hand nor commensurate in scope with the instant claims.

Art Unit: 1765

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571)272-1079.

/Rabon Sergent/
Primary Examiner, Art Unit 1765